

Serial No. 09/844,051

PATENT
Attorney Docket No. 2001B035REMARKS

Applicants respectfully request entry of this Amendment and reconsideration of this application, as amended.

Claims 1 through 3 have been cancelled, claims 4 through 16 presently stand rejected, and claim 17 has been added, leaving claims 4 through 17 presently pending in the application.

Rejection Under 35 USC 112

With respect to claim 4, the Examiner previously indicated that the phrase "substantially free of sulfided hydrogenation metal" was indefinite. The specification makes clear on page 6, lines 26 to 27, that no sulfided hydrogenation metal is intended. Based on the assertion above, it would be clear to one of ordinary skill in the art that "substantially free of sulfided hydrogenation metal" would mean that none was intentionally added and that any amount present would be minimal. To further clarify this distinction, the term "substantially" was replaced (by amendment dated March 12, 2003) with the term "essentially," which has been found to be definite under analogous circumstances. *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (CCPA 1983)

The Examiner rejected the amended claim 4, stating that the term "essentially" was new matter. Applicants respectfully request reconsideration of this rejection. The language of this application cited above is analogous to the language found to define "essentially" in *Marosi*.

In the alternative, Applicants request that the Examiner reconsider the original rejection of the term "substantially." New claim 17 is submitted to reinstate claim 4 as it was originally presented. It is submitted that the definition clearly differentiates from the process described in the Suggitt et al. patent (U.S. Patent No. 3,780,123). Accordingly, it is respectfully urged that the Examiner withdraw this rejection.

Rejection Under 35 USC 103(a)

Claims 4 through 10 and 14 through 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Suggitt et al. (U.S. Patent No. 3,780,123). In

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particular, the Examiner argues that Suggitt et al. teach a process of disproportionation of cumene in the presence of a mordenite catalyst to produce a product containing benzene and a mixture of diisopropylbenzene isomers.

It is respectfully noted that Suggitt et al. require the presence of a sulfided hydrogenation metal and teach that the catalyst would deactivate rapidly without the metal, thereby teaching away from the present invention. The disclosure of Suggitt et al. also requires a sulfide compound added to the reaction mixture to maintain catalyst activity (column 3, line 73 through column 4, line 16; Example VI; and claim 1). Claim 4 and dependent claims 5 through 16 of the present application require neither sulfided hydrogenation metal nor a sulfide compound in the feed in order to disproportionate cumene to produce DIPB isomers. Applicants respectfully note that the omission of an element and retention of its function is an indicia of unobviousness. *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966).

The Examiner has rejected claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Suggitt et al. (U.S. Patent No. 3,780,123) in view of Calabro et al. (U.S. Patent No. 6,049,018). Applicants respectfully apply the same arguments as above with respect to Suggitt et al. and respectfully submit that unobviousness in light of the Suggitt et al. disclosures renders further discussion of Calabro et al. unnecessary.

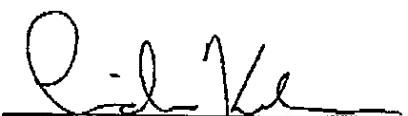
With the amendments made herein and in light of the clarifications above, it is respectfully submitted that the claims are in condition to be allowed under 35 U.S.C. § 103(a). Accordingly, it is respectfully urged that the Examiner withdraw this rejection.

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In view of the foregoing comments, entry of this Amendment and allowance of this application is earnestly solicited. Should the Examiner have any further comments or questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

Date 1/12/04

Linda A. Kubena
Attorney for the Applicants
Registration No. 42,772

ExxonMobil Chemical Company
Law Technology
P. O. Box 2149
Baytown, Texas 77522-2149
Telephone: (281) 834-2429
Facsimile: (281) 834-2495

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